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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,587	04/14/2000	JOHN A. DANE	EPRNT-101XX	2045

7590 10/01/2003  
Patent Legal Staff  
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EXAMINER

TODD, GREGORY G

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 10/01/2003

1.0

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/529,587

Applicant(s)

DANE ET AL.

Examiner

Gregory G Todd

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-8, 10-12, 14-20, 23-28 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-8, 10-12, 14-20, 23-28 and 30-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

This is a second office action in response to applicant's amendment filed, 11 July 2003, of application filed, with the above serial number, on 14 April 2000 in which claims 3-7, 10-12, 15-16, 19-20, 23-27, and 30-31 have been amended, claims 8, 14, 17-18, and 28 have been unaltered, claims 1-2, 9, 13, 21-22, and 29 have been cancelled and claims 32-34 have been added. Claims 3-8, 10-12, 14-20, 23-28 and 30-34 are therefore pending in the application.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 33, 10, 16-17, 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Maniwa (hereinafter "Maniwa", 5,764,866).

3. As per Claim 33, Maniwa discloses a method of remotely uploading, storing, reviewing, and editing electronic photographic images, wherein Maniwa discloses:

fixing visual images on a persistent medium (image to be scanned) (at least col.

5, lines 48-53);

translating said visual images into electronic photographic images (scanning) (at least col. 5, lines 48-56);

transmitting said electronic photographic images to an order server (file/scan server) (at least col. 20, lines 16-22; col. 19, lines 48-50);

sequencing and captioning said electronic photographic images (image file - 1...m) (at least Fig. 6);

storing said electronic photographic images on a memory at said order server (at least col. 19, lines 48-50);

displaying selected electronic photographic images from said memory to a remote customer (list user obtains) (at least col. 21, lines 52-62);

receiving an order from said remote customer enumerating a subset of said electronic photographic images (sending file request command for printout) (at least col. 20, lines 5-15);

producing a hardcopy rendition of said subset of electronic photographic images (printing) (at least col. 20, lines 51-54).

4. As per Claim 10.

wherein said translating comprises scanning a visual image into a digital storage format (at least col. 18 line 66 - col. 19 line 4).

5. As per Claim 16.

wherein said displaying is followed by the step of electing a quantitative and qualitative assertion for at least one of said electronic photographic images (user selecting one or more displayed images) (at least col. 21, lines 52-62).

6. As per Claim 17.

wherein said electing further comprises storing at least one of said electronic photographic images in an electronic proofbook (directory service for user image list) (at least col. 21, lines 52-62).

7. As per Claim 19, has substantially similar content to claim 16 and is rejected as per claim 16.

8. As per Claim 20.

wherein said storing is preceded by the step of remotely altering/editing said electronic photographic images (image resolution conversion, rotation, etc) (at least col. 18, lines 17-58).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-8, 12, 14-15, 23-32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maniwa (hereinafter "Maniwa", 5,764,866) in view of Wilf et al (hereinafter "Wilf", 5,899,980) and further in view of Westmoreland (hereinafter "DMW", DMW Photo Images).

11. As per Claims 32 and 34, Maniwa discloses a computer method for storing and saving electronic photographic images, wherein Maniwa discloses:

providing access to a server (scan server) having picture memory adapted to store said electronic photographic images, an ordering interface and a communication link (digital copier device over LAN) (at least col. 5, lines 48-67; Fig. 7);

providing access to said electronic photographic images stored in said picture memory, said ordering interface further providing access to an image profiler adapted to sequence and label (image file - 1...m) (at least Fig. 6) said stored electronic photographic images (scanning/storing at file-server) (at least col. 5, lines 48-56; col. 19, lines 28-43);

wherein said ordering interface is operable to be remotely accessed by said customer of said photographer for the purpose of ordering an image product with respect to said stored electronic photographic images (controlling of printer unit) (at least col. 6 line 61 - col. 7 line 5; col. 8, lines 6-16; Fig. ).

Maniwa does not disclose providing access to a server adapted to transact remote payment with respect to a financial institution for verifying payment of an order places through said ordering interface. However, the use and advantages for using such a payment method is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Wilf. Wilf discloses verifying and validation payment of goods purchased at a point-of-sale computer workstation (at least col. 11 line 57 - col. 12 line 5; abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Wilf's payment and verification method into Maniwa's system because this would allow Maniwa's system to be used over a WAN such as the internet and the file and print

server to be used in conjunction with selling consumer electronic photos as this would expand and enhance Maniwa's system to reach more consumers and provide a faster, easier payment method.

Maniwa does not explicitly disclose said electronic photographic images obtained by a photographer at a customer event. However, the use and advantages for using such a photo arrangement is very well known to one skilled in the art at the time the invention was made as evidenced by the teachings of DMW (at least pp. 1, 4). DMW discloses arranging photos according to Rock, alternative, etc. Further, it is very well known that images are most commonly taken by a user with a camera, aka photographer, to capture a particular moment in time, such as an event, and that this limitation is irrelevant as to the novelty of the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the use of DMW's genre photo arrangement into Maniwa's storing files in a directory service as this would enhance Maniwa's system by allowing the image files to be stored in the directory by an easy to remember method such as a meeting or date, etc.

12. As per Claims 3 and 23.

wherein said ordering interface access providing step further comprises providing access to a customer order selector adapted to enumerate and quantify a subset of said electronic photographic images to be produced as said hardcopy renditions (sending file request command for printout) (at least col. 20, lines 5-15).

13. As per Claims 4 and 24.

wherein said ordering interface access providing step further comprises providing access to a customer proofbook adapted to store a subset of said electronic photographic images, wherein said customer proofbook persists between said remote accesses by said customer (directory service for user image list) (at least col. 21, lines 52-62).

14. As per Claims 5 and 25.

Maniwa does not disclose wherein said payment verifier access providing step enables transmitting payment corresponding to production of said hardcopy renditions in response to notification from said financial institution. However, the use and advantages for using such a payment confirmation is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Wilf. Wilf discloses the server verification confirmation indicating to supply goods upon payment (at least Fig. 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Wilf's payment and verification method into Maniwa's system because this would allow Maniwa's system to only continue with the printing process if the user is authorized to print, as this would further reduce unwanted workload on Maniwa's host machine (Maniwa col. 4, lines 25-30).

15. As per Claims 6 and 26.

wherein said image loader access providing step enables receiving said electronic photographic images from a transmission over a publicly accessible network through said communications link (at least col. 21, lines 44-51; col. 22, lines 15-21).

16. As per Claims 7 and 27.



wherein said image loader access providing step enables receiving said electronic photographic images from a non-volatile digital media (hard drive) (at least col. 7, lines 29-30).

17. As per Claims 8 and 28.

wherein said non-volatile digital media is selected from the group consisting of magnetic and optical formats (hard drive) (at least col. 7, lines 29-30).

18. As per Claim 12.

Maniwa discloses a multi-network environment but does not explicitly disclose transmission over a publicly accessible network. However, the use and advantages for using such a network is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Wilf. Wilf discloses using the internet for authorizing transactions (at least Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the use of a public network such as the internet with Maniwa's multi-network system as this would enhance the reach of Maniwa's system with more vendors.

19. As per Claim 14.

wherein said displaying is in response to interactive selecting by said customer through said publicly accessible network (user selecting image file) (at least col. 21, lines 52-62).

20. As per Claim 15.

Maniwa does not explicitly disclose arranging said electronic photographic images according to an event and said displaying said electronic photographic images

occurs selectively according to said event. However, the use and advantages for using such a photo arrangement is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of DMW (at least pp. 1, 4). DMW discloses arranging photos according to Rock, alternative, etc. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the use of DMW's genre photo arrangement into Maniwa's storing files in a directory service as this would enhance Maniwa's system by allowing the image files to be stored in the directory by an easy to remember method such as a meeting or date, etc.

21. As per Claim 30.

further including the step of providing access to stored images for allowing image editing (image resolution conversion, rotation, etc) (at least col. 18, lines 17-58).

22. As per Claim 31.

wherein said editing step includes one or more of the steps of categorizing, sorting and titling (image file ID/name) (at least col. 14, lines 25-28).

23. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maniwa in view of Wilf and further in view of Morag et al (hereinafter "Morag", 6,058,399).

Maniwa and Wilf do not disclose using a digital camera to store said visual images therein. However, the use and advantages for using such an electronic photo capturing is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Morag (at least col. 6, lines 44-49). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made

to incorporate using a digital camera to create electronic photos to print as this was a commonly used method and alternative of creating digital photos along with scanning film.

24. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maniwa.

Maniwa discloses a user directory service for storing and organizing image data files but does not explicitly disclose wherein said electronic proofbook is accessible only by said customer. Official notice is taken that it was well known in the art at the time the invention was made to have authenticity measures so that only a specified user can access particular files. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement having users password protect files and/or a directory because this would prevent unauthorized users from viewing image data files that are confidential or private.

### ***Response to Arguments***

25. Applicant's arguments filed 11 July 2003 have been fully considered but they are not persuasive.

The applicant argues, substantially, that Maniwa fails to disclose sequencing and labeling images and that images are captured by a photographer on behalf of a customer at an event.

26. In response, Maniwa clearly discloses, as previously cited in Fig. 6, the images as having been formatted and accordingly given an attribute of image file 1-m and therefore sequenced and labeled accordingly for a directory service.

27. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., photographer on behalf of a customer at an event) were not recited in the original rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The rejection has been amended to overcome the newly cited limitation.

28. In response to applicant's argument that Maniwa is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Maniwa clearly discloses transmitting digital image files over a network which is clearly analogous art to that which is claimed.

### ***Conclusion***

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

30. Martin et al (payment server), Moghadam et al (networking photos), Brindle et al (photo description), Yien et al (networked image editing), Loeb (multimedia, photo delivery mechanisms), Woods (Kodak abstract for system claimed dated August '97), DaleLabs (digital film developing), Oldroyd Digital (digital film printing and editing), and WebPhotos (a very identical system to that claimed) are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.


31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory G Todd whose telephone number is (703)305-5343. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

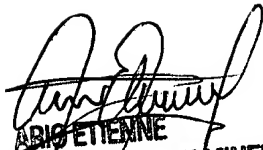
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Gregory Todd 

Patent Examiner

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